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ELI LILLY AND COMPANY

By Gimda M. Dunbar

Date May 20, 2003

REISSUE PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of
U.S. Patent No. 5,945,416

Applicants: Shannon, et al.

Application No.: 09/935,513

Filed: August 22, 2001

For: METHOD FOR TREATING PAIN

Docket No.: X-10576A

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) Confirmation No.:
) 9165
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) Group Art Unit:
) 1617
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) Examiner:
) Theodore J. Criares
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REMARKS PURSUANT TO 37 C.F.R. § 1.111

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

In the Office Action of March 12, 2003, the Office rejected claims 1-44, 60-67, and 81-91 under various arguments which are individually considered by Applicants below. An Information Disclosure Statement and Terminal Disclaimer is submitted herewith. A clean set of pending claims 1-44, 60-67, and 81-91 is attached herewith in Appendix B for the Office's convenience.

REMARKS

An Information Disclosure statement was filed in the present reissue application on September 20, 2001, a copy of which is attached herewith. Applicants have not received the corresponding initialed Form 1449 indicating that the Office considered the references cited therein. Applicants therefore respectfully request that the Office provide such confirmation of consideration by returning the corresponding initialed Form 1449 to the Applicants.

Serial No. 09/935,513

In addition, Applicants wish to bring to the Office's attention that U.S. Patent No. 6,147,072, cited in the IDS first filed with this response, was filed as a Reissue Application on October 31, 2002 and was assigned Serial Number 10/285,890, Art Unit 1614.

DOUBLE PATENTING REJECTION

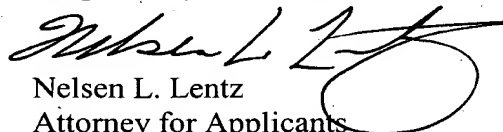
The Office rejected claims 1-44, 60-67, and 81-91 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, and 5 of U.S. Patent No. 5,972,932. While Applicants do not necessarily agree with the Office's assessment of the claims under the obviousness-type double patenting rejection, Applicants provide, only in order to expedite prosecution, a terminal disclaimer pursuant to 37 C.F.R. § 1.321. Applicants further submit that the filing of this terminal disclaimer is not an admission or acquiescence by, nor shall act as an estoppel upon, the Applicants on the merits of the rejection. In addition, in order to clarify the record relating to the present double patenting rejection, Applicants submit that the body of claims 1 to 27, 60-67, and 81-89 defines a structurally complete invention and the preamble of said claims merely states an intended use for the invention.

REQUEST FOR SUPPLEMENTAL DECLARATION

Pursuant to 37 C.F.R. 1.175(b)(1), the Office asserted that a new reissue oath/declaration must be received before the present reissue application can be allowed. In compliance with this request, Applicants submit herewith a Supplemental Reissue Declaration which sets forth specific errors.

In view of the above remarks and documents attached herewith, Applicants submit that claims 1-44, 60-67, and 81-91 are in condition for allowance. Reconsideration and withdrawal of the rejections is respectfully requested and allowance of claims 1-44, 60-67, and 81-91 is kindly solicited.

Respectfully submitted,



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